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SCULLY, SCOTT, MURPHY & PRESSER, P.C.

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To: Attention: Refunds
U.S. Patent and Trademark Office

From: Anna Eberle for Paul J. Esatto, Jr.

Fax: 571-273-6500 **Pages:** 16

Phone: **Date:** 8/28/2006

Re: USSN: 10/536,597
Filed: May 26, 2005
Our Docket: 18886

CC:

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

• **Comments:**

Deposit Account 19-1013 was erroneously charged $50.00 in December 2005 for an extra claim fee. There are 32 claims in the application according to the Preliminary Amendment. We paid for 32 claims with 4 extra independent claims. A copy of the Transmittal Letter and Preliminary Amendment are enclosed, as well as the deposit account statement from December. Therefore, the $50.00 fee was not required. Please credit the deposit account with the $50.00.

Thank you.

If you have any problems concerning this facsimile, please call (516) 742-4343 and ask for Anna Eberle x 560.

Adjustment Date: 10/06/2006 HOLLAND 00000001 191013 10536597
12/12/2005 01 FC:1615 50.00 CR

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Deposit Account Statement

Requested Statement Month:	December 2005
Deposit Account Number:	191013
Name:	SCULLY, SCOTT, MURPHY & PRESSER
Attention:	LINDA ANN HAGEMEYER
Address:	A PROFESSIONAL CORPORATION
City:	GARDEN CITY
State:	NY
Zip:	11530-0299
Country:	UNITED STATES

DATE	SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
12/01	4	11288552	19367	1201	$600.00	$15,967.88
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12/12	93	2299205	23/1016	8521	$40.00	$20,192.88
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12/23	291	09728552	11445Z & 11445	1801	$790.00	$18,782.88
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12/27	91	78161882	66/1170	7004	$450.00	$16,912.88
12/27	106	10660400	14862Z	1814	$130.00	$16,782.88
12/28	9	09802248	14031(YOR920	1251	$120.00	$16,662.88
12/28	61	09854123	14617	1801	$790.00	$15,872.88
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12/28	150	10696086	14399Z	8001	$9.00	$15,413.88
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12/29	47	10452328	OSP-13987	1251	$120.00	$15,669.88
12/29	98	1310876	64/1001	8521	$40.00	$15,629.88
12/30	2	PCT/US04/31823	YOR920030293	1608	$150.00	$15,479.88
12/30	37	E-REPLENISHMENT		9203	-$25,000.00	$40,479.88

START BALANCE	SUM OF CHARGES	SUM OF REPLENISH	END BALANCE
$16,567.88	$16,533.00	$40,445.00	$40,479.88

Deposit Account Statement

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FORM PTO-1390 (Modified) (REV. 2-2005) U.S. PATENT AND TRADE OFFICE; U.S. DEPARTMENT OF COMMERCE

TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A SUBMISSION UNDER 35 U.S.C. 371

ATTORNEY'S DOCKET NUMBER	
18886	
U.S. APPLICATION NO. (If known, see 37 CFR 1.5)	
INTERNATIONAL APPLICATION NO. PCT/JP2003/015256	INTERNATIONAL FILING DATE 28 November 2003 (28.11.2003)
PRIORITY DATE CLAIMED 29. November 2002 (29.11.2002)	

TITLE OF INVENTION
MICROCHIP AS WELL AS SOLVENT DISPLACING METHOD, CONCENTRATING METHOD AND MASS SPECTROMETRY SYSTEM THEREWITH

APPLICANT(S) FOR DO/EO/US
Masakazu Baba, Toru Sano, Kazuhiro Iida, Hisao Kawaura, Noriyuki Iguchi, Wataru Hattori, Hiroko Someya, Minoru Asogawa

Applicant herewith submits to the United States Designated/Elected Office (DO/EO/US) the following items and other information:

1. ☒ This is a **FIRST** submission of items concerning a submission under 35 U.S.C. 371.
2. ☐ This is a **SECOND** or **SUBSEQUENT** submission of items concerning a submission under 35 U.S.C. 371.
3. ☒ This is an express request to begin national examination procedures (35 U.S.C. 371(f)). The submission must include items (5), (6), (9) and (24) indicated below.
4. ☒ The US has been elected (Article 31).
5. ☒ A copy of the International Application as filed (35 U.S.C. 371 (c)(2))
   a. ☐ is attached hereto (required only if not communicated by the International Bureau).
   b. ☒ has been communicated by the International Bureau.
   c. ☐ is not required, as the application was filed in the United States Receiving Office (RO/US).
6. ☒ An English language translation of the International Application as filed (35 U.S.C. 371(c)(2)).
   a. ☒ is attached hereto.
   b. ☐ has been previously submitted under 35 U.S.C. 154(d)(4).
7. ☒ Amendments to the claims of the International Application under PCT Article 19 (35 U.S.C. 371 (c)(3))
   a. ☐ are attached hereto (required only if not communicated by the International Bureau).
   b. ☐ have been communicated by the International Bureau.
   c. ☐ have not been made; however, the time limit for making such amendments has NOT expired.
   d. ☒ have not been made and will not be made.
8. ☐ An English language translation of the amendments to the claims under PCT Article 19 (35 U.S.C. 371(c)(3)).
9. ☒ An oath or declaration of the inventor(s) (35 U.S.C. 371 (c)(4)).
10. ☐ An English language translation of the annexes to the International Preliminary Examination Report under PCT Article 36 (35 U.S.C. 371 (c)(5)).
11. ☐ A copy of the International Preliminary Examination Report (PCT/IPEA/409).
12. ☒ A copy of the International Search Report (PCT/ISA/210).

Items 13 to 23 below concern document(s) or information included:

13. ☒ An Information Disclosure Statement under 37 CFR 1.97 and 1.98.
14. ☒ An assignment document for recording. A separate cover sheet in compliance with 37 CFR 3.28 and 3.31 is included.
15. ☒ A **FIRST** preliminary amendment.
16. ☐ A **SECOND** or **SUBSEQUENT** preliminary amendment.
17. ☐ A substitute specification.
18. ☐ A power of attorney and/or change of address letter.
19. ☐ A computer-readable form of the sequence listing in accordance with PCT Rule 13*ter*.2 and 37 CFR 1.821 - 1.825.
20. ☐ A second copy of the published International Application under 35 U.S.C. 154(d)(4).
21. ☐ A second copy of the English language translation of the International Application under 35 U.S.C. 154(d)(4).
22. ☒ Express Mail Label No. EV213896935US
23. ☒ Other items or information:

Thirty-three (33) sheets of drawings
Assignee: NEC Corporation of Tokyo, Japan

PTO-1390 (Rev. 02-2005)
Appr for use through 3/31/2007. OMB 0651-0021
U.S. Patent and Tradema. ffice; U.S. DEPARTMENT OF COMMERCE
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U.S. APPLICATION NO (if known, see 37 CFR 1.5)	INTERNATIONAL APPLICATION NO.	ATTORNEY'S DOCKET NUMBER
	PCT/JP2003/015256	18886

The following fees are submitted:		CALCULATIONS	PTO USE
24. ☒ Basic national fee	$300	$ $300.00	
25. ☒ Examination fee If international preliminary examination report prepared by USPTO and all claims satisfy provisions of PCT Article 33(1)-(4)	$100	$ $200.00	
All other situations	$200		
26. ☒ Search fee			
Search fee (37 CFR 1.445(a)(2)) has been paid on the international application to the USPTO as an International Searching Authority	$100		
International Search Report prepared and provided to the Office	$400		
All other situations	$500	$ $400.00	
TOTAL OF 24, 25 and 26 =		$ $900.00	

☐ Additional fee for specification and drawings filed in paper over 100 sheets (excluding sequence listing or computer program listing filed in an electronic medium). The fee is $250 for each additional 50 sheets of paper or fraction thereof.

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof (round up to a whole number)	RATE		
87 - 100 =	0 /50 =	0	x $250.00	$ $0.00	

Surcharge of $130.00 for furnishing the oath or declaration later than months from the earliest claimed priority date (37 CFR 1.492(e)). $

CLAIMS	NUMBER FILED	NUMBER EXTRA	RATE		
Total claims	** 32 - 20 =	12	x $50.00	$ $600.00	
Independent claims	7 - 3 =	4	x $200.00	$ $800.00	
MULTIPLE DEPENDENT CLAIMS (if applicable)	☐		+ $360.00	$ $0.00	
TOTAL OF ABOVE CALCULATIONS =				$ $2,300.00	
☐ Applicant claims small entity status. See 37 CFR 1.27. The fees indicated above are reduced by 1/2.				$ $0.00	
SUBTOTAL =				$ $2,300.00	
Processing fee of $130.00 for furnishing the English translation later than 30 months from the earliest claimed priority date (37 CFR 1.492(f)).			+	$ $0.00	
TOTAL NATIONAL FEE =				$ $2,300.00	
Fee for recording the enclosed assignment (37 CFR 1.21(h)). The assignment must be accompanied by an appropriate cover sheet (37 CFR 3.28, 3.31). $40 per property			+	$ $0.00	
TOTAL FEES ENCLOSED =				$ $2,300.00	

**Please see Preliminary Amendment for claim count.

Amount to be refunded: $

Amount to be charged: $

a. ☒ A check in the amount of $ $2,300.00 to cover the above fees is enclosed.

b. ☐ Please charge my Deposit Account No. _____ in the amount of _____ to cover the above fees. A duplicate copy of this sheet is enclosed.

c. ☒ The Director is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 19-1013 SSMP. A duplicate copy of this sheet is enclosed.

d. ☐ Fees are to be charged to a credit card. **WARNING:** Information on this form may become public. **Credit card information should not be included on this form.** Provide credit card information and authorization on PTO-2038.

NOTE: Where an appropriate time limit under 37 CFR 1.495 has not been met, a petition to revive (37 CFR 1.137(a) or (b)) must be filed and granted to restore the International Application to pending status.

SEND ALL CORRESPONDENCE TO:

Paul J. Esatto, Jr.
Customer No. 23389
Scully, Scott, Murphy & Presser

SIGNATURE

Paul J. Esatto, Jr.,
NAME

30,749
REGISTRATION NUMBER

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10) Applicant(s): Masakazu Baba, et al.			Docket No. 18886	
Application No. unassigned	Filing Date herewith	Examiner unassigned	Customer No. 23389	Group Art Unit unassigned

Invention: **MICROCHIP AS WELL AS SOLVENT DISPLACING METHOD, CONCENTRATING METHOD AND MASS SPECROMETRY SYSTEM THEREWITH**

I hereby certify that the following correspondence:

New U.S. Patent Application Under 35 U.S.C. 371

(Identify type of correspondence)

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on **May 26, 2005**
(Date)

Paul J. Esatto, Jr.
(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

EV213896935US
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P06A/REV03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s):	Masakazu Baba, et al.	**Examiner:**	Unassigned
Serial No:	Unassigned	**Art Unit:**	Unassigned
Filed:	Herewith	**Docket:**	18886
For:	MICROCHIP AS WELL AS SOLVENT DISPLACING METHOD, CONCENTRATING METHOD AND MASS SPECTROMETRY SYSTEM THEREWITH	**Dated:**	May 26, 2005

Mail Stop PCT
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

PRELIMINARY AMENDMENT

Sir:

In connection with the above-identified patent application, kindly enter the following preliminary amendment.

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Mailing Label Number: EV213896935US
Date of Deposit: May 26, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service Express Mail Post Office to Addressee service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

Dated: May 26, 2005

Paul J. Esatto, Jr.

g\nec\1765\18886\amend\18886.aml

In the Claims:

This listing of claims will replace all prior versions, and listings, of claims in the application:

Listing of Claims:

1. A microchip on a substrate, comprising a channel for a liquid sample containing a particular component and a sample feeding part provided in said channel,

wherein said channel is branched into a first channel and a second channel, an inlet of said first channel from said sample feeding part has a filter for preventing passage of said particular component, and an inlet of said second channel from said sample feeding part has a damming area preventing passage of said liquid sample while permitting said liquid sample to pass when an external force equal to or larger than a given level is applied.

2. The microchip as claimed in Claim 1, wherein said damming area is a lyophobic area.

3. The microchip as claimed in Claim 1 [[or 2]], wherein said liquid sample which has passed through said filter moves by capillary action.

4. The microchip as claimed in ~~any one of Claims 1 to 3~~ Claim 1, wherein said first channel further comprises an inflow stopper downstream of said filter for preventing a liquid from flowing into said first channel.

5. The microchip as claimed in Claim 4, wherein said inflow stopper prevents a liquid from flowing into said first channel when a predetermined amount of liquid enters said first channel.

6. The microchip as claimed in Claim 4 [[or 5]], further comprising external force applying means for applying an external force to a liquid sample flowing said channel,

wherein said external force applying means applies an external force to a sample such that when inflow of a liquid into said first channel is stopped by said inflow stopper, said liquid sample flows over said lyophobic area into said second channel.

7. The microchip as claimed in ~~any one of Claims 1 to 6~~ Claim 1, wherein said filter is comprised of a plurality of pillars.

8. The microchip as claimed in ~~any one of Claims 1 to 6~~ Claim 1, wherein said filter is an aluminum oxide, a porous film or a polymer gel film.

9. A microchip on a substrate, comprising a channel for a liquid sample containing a particular component and a plurality of discharge channels along the sidewall of said channel, wherein said discharge channels prevent passage of said particular component.

10. A microchip on a substrate, comprising a channel for a liquid sample containing a particular component and a filter disposed to block the flow in said channel for preventing passage of said particular component, wherein said channel comprises a branched part consisting of a sample feeding part and a sample recovering part in one side and a solvent feeding part in the other side.

11. The microchip as claimed in Claim 10, further comprising a discharging part disposed at a position other than said solvent feeding part in the other side of said filter, from which said liquid sample passing through said filter is discharged.

12. The microchip as claimed in Claim 11, wherein said liquid sample passing through said filter moves by capillary action.

13. The microchip as claimed in ~~any one of Claims 10 to 12~~ Claim 10, wherein said solvent feeding part comprises a damming area preventing a liquid from entering from the direction of said filter while facilitating discharge of the liquid toward said filter.

14. The microchip as claimed in ~~any one of Claims 10 to 13~~ Claim 10, wherein said sample feeding part comprises a damming area preventing a liquid from entering from the direction of said filter while facilitating discharge of the liquid toward said filter.

15. The microchip as claimed in Claim 13 [[or 14]], wherein said damming area is a lyophobic area.

16. A microchip on a substrate, comprising a channel including a first channel in which a liquid sample containing a particular component flows and a second channel extending along said first channel, and a filter intervening between said first channel and said second channel for preventing passage of said particular component,

wherein said first channel includes a sample feeding part for introducing said liquid sample upstream in the flowing direction and said second channel comprises a substituting solvent feeding part at a position corresponding to the downstream in the flowing direction in said first channel.

17. The microchip as claimed in Claim 16, further comprising an external force applying means which applies an external force to said first channel and said second channel in different directions.

18. The microchip as claimed in Claim 17, wherein said external force applying means applies a larger external force to said first channel than to said second channel.

19. A microchip on a substrate, comprising a channel for a liquid sample containing a particular component and an electrode formed in said channel,

wherein said electrode has a charge having a different polarity from that of said particular component.

20. A process for concentrating a particular component in a liquid sample using said microchip as claimed in ~~any one of Claims 1 to 8~~ Claim 1, comprising the steps of

applying an external force enough to introduce the liquid sample containing said particular component and a solvent into said sample feeding part but not enough for said liquid sample to pass through said damming area;

applying an external force comparable to that applied in said step of introducing said liquid sample to said sample feeding part to introduce said solvent or another solvent into said sample feeding part for a given period; and

stopping said flow of the liquid into said first channel.

21. The process for concentrating as claimed in Claim 20, wherein in said step of stopping said flow of said liquid into said first channel, an external force larger than that in any other steps is applied.

22. A process for replacing a solvent in a liquid sample containing a particular component using said microchip as claimed in ~~any one of Claims 1 to 8~~ Claim 1, comprising the steps of

applying an external force enough to introduce the liquid sample containing said particular

component and a first solvent into said sample feeding part but not enough for said liquid sample to pass through said damming area;

applying an external force comparable to that applied in said step of introducing said liquid sample to said sample feeding part to introduce a solvent other than said first solvent into said sample feeding part for a given period; and

stopping said flow of the liquid into said first channel.

23. The process for replacing a solvent as claimed in Claim 22, wherein in said step of preventing a liquid from flowing into said first channel, an external force larger than that in any other steps is applied.

24. A process for concentrating a particular component in a liquid sample using said microchip as claimed in ~~any one of Claims 10 to 15~~ Claim 10, comprising the steps of

introducing the liquid sample containing said particular component and a solvent into said sample feeding part; and

recovering said particular component from said sample recovering part by introducing another solvent from a solvent feeding part.

25. The process for concentrating as claimed in Claim 24, further comprising the step of introducing one of the solvents from said sample feeding part, between said steps of introducing said liquid sample and recovering said liquid sample.

26. A process for replacing a solvent in a liquid sample containing a particular component using said microchip as claimed in ~~any one of Claims 10 to 15~~ Claim 10, comprising the steps of

introducing the liquid sample containing said particular component and a first solvent into said sample feeding part; and

recovering said particular component from said sample recovering part by introducing a second solvent other than said first solvent from said solvent feeding part.

27. The process for replacing a solvent as claimed in Claim 26, further comprising the step of introducing said second solvent from said sample feeding part, between said steps of introducing said liquid sample and recovering said liquid sample.

28. A process for replacing a solvent in a liquid sample using a separator comprising a first channel and a second channel for a liquid sample containing a particular component and a filter intervening between said channels, comprising the step of

moving the liquid sample containing said particular component and a first solvent in said first channel in a first direction; and

simultaneously moving a second solvent in said second channel in a direction different from said first direction,

wherein a ratio of said second solvent to said first solvent increases as said liquid sample is moved in said first channel.

29. The process for replacing a solvent as claimed in Claim 28, wherein an external force applied for moving said liquid sample containing said particular component and said first solvent in said first channel in said first direction is larger than an external force for moving said second solvent in said second channel in a direction different from said first direction, to concentrate said particular component in the downstream of said first channel.

30. A process for replacing a solvent in a liquid sample containing a particular component using a channel comprising an electrode, comprising the steps of

feeding the liquid sample containing said particular component and a first solvent into said channel while charging said electrode with an opposite polarity to said particular component;

feeding a second solvent into said channel while maintaining said charge of said electrode; and

discharging said electrode and recovering said particular component together with said second solvent.

31. The process for replacing a solvent as claimed in Claim 30, wherein said electrode has a charge with the same polarity as said particular component in said step of recovery.

32. A mass spectrometry system comprising

pretreatment means for separating a biological sample by a molecular size or properties while pretreating said sample for preparation for enzymatic digestion;

means for enzymatically digesting said pretreated sample;

drying means for drying said enzymatically digested sample; and

mass spectrometry means for analyzing said dried sample by mass spectrometry,

wherein said pretreatment means comprises said microchip as claimed in ~~any one of Claims 1 to 19~~ Claim 1.

REMARKS

Applicants submit that the foregoing amendments to the claims, made to correct multiple claim dependencies and do not introduce new matter into the application. Wherefore, early and favorably consideration of the present application, as amended herein, is respectfully requested.

Respectfully submitted,

Paul J. Esatto, Jr.
Registration No. 30,749

SCULLY, SCOTT, MURPHY & PRESSER
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343

PJE:ae

PATENT APPLICATION SERIAL NO. 10/536597

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
FEE RECORD SHEET

06/02/2005 MKAYPAGH 00000154 10536597

01 FC:1631 300.00 DP
02 FC:1642 400.00 DP
03 FC:1633 200.00 DP
04 FC:1615 600.00 DP
05 FC:1614 800.00 DP

12/12/2005 KMCLEAN1 00000001 191013 10536597

01 FC:1615 50.00 DA

PTO-1556
(5/87)

Adjustment date: 10/06/2006 THOLLAND
12/12/2005 KMCLEAN1 00000001 191013 10536597
01 FC:1615 50.00 CR

*U.S. Government Printing Office: 2002 — 489-267/60033